

CUSTOMER NO. 46850

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Attorney Docket No. Basavanhally 31-3

In re application of: Nagesh R. Basavanhally and Hong Tang

Serial No.:	<u>10/602,476</u>	Group Art Unit:	<u>2883</u>
Filed:	<u>06/24/2003</u>	Examiner:	<u>Chiem, Dinh D.</u>
Matter No.:	<u>990.0487</u>	Phone No.:	<u>571-272-3102</u>

For: Fiber-Optic Gauge Having One or More Side-Mounted Sensors

PETITION TO THE DIRECTOR TO REVIEW
REQUIREMENT OF RESTRICTION UNDER 37 CFR 1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Petition is filed in response to the office action of 03/03/2010.

Procedural Posture

In the office action of 10/05/2005, the Examiner issued a restriction requirement for claims 1-20.

In the response of 11/07/2005, the Applicants requested reconsideration of the restriction requirement and provisionally elected claims 1-3, 9, 10, 17-19, and 20 with traverse. The Applicants further requested that claims 4-5, 7-8, and 11-13 be added to the provisional election.

In the office action of 02/15/2006, the Examiner examined claims 1-3, 9, 11-12, and 17-20 on the merits and withdrew claims 4-8, 10, and 13-16 from consideration.

In the response of 06/29/2006, the Applicants added new claims 21-23 and argued for the allowability of all pending claims.

In the office action of 08/24/2006, the Examiner found the Applicants' arguments persuasive, withdrew the restriction requirement, and examined all pending claims (i.e., claims 1-23) on the merits. The Examiner objected to claims 4-8 and 13-16 as being dependent upon a rejected base claim, but indicated that those claims would be allowable if rewritten in independent form.

In the response of 11/20/2006, the Applicants canceled claim 2 and added new claims 24-28. Of the new claims, claims 25, 27, and 28 were equivalent to original claims 13, 15, and 16, respectively, rewritten in independent form, and claim 26, which depended from claim 25, was equivalent to original claim 14.

In the office action of 07/03/2007, the Examiner reinstated the restriction requirement and withdrew claims 4-8, 13-15, and 25-28 from consideration.

On 10/03/2007, the Applicants filed PETITION TO THE DIRECTOR TO REVIEW REQUIREMENT OF RESTRICTION UNDER 37 CFR 1.144.

The petition was granted and the restriction requirement was withdrawn.

In the office action of 12/04/2008, the Examiner again examined all pending claims (i.e., claims 1 and 3-28) on the merits.

Applicants' response of 03/03/2009 overcame the rejections.

In the office action of 06/12/2009, the Examiner yet again examined all pending claims (i.e., claims 1 and 3-28) on the merits.

In the response of 10/12/2009, the Applicants canceled claims 10, 13-14, 19-21, and 24-28, amended claims 1, 8, 12, and 16-17, and added new claim 29.

In the office action of 03/03/2010, the Examiner issued a restriction requirement and withdrew claims 17-18 and 23 from consideration.

Restriction Requirement Has Improper Form

MPEP § 803(I) provides that, for the restriction requirement to be proper, "Examiners must provide reasons and/or examples to support conclusions;" and MPEP § 808.02 further provides that, where related inventions are shown to be distinct, a restriction requirement must show by appropriate explanation one of the following: (i) separate classifications, (ii) separate status of the art, and (iii) a different field of search. The Applicant submits that the office action contains only a conclusion stating that "an FPI is a separate species" and does not give any explanation, in the MPEP-mandated form, as to why the FPI species is distinct from the previously examined species. In particular, the restriction requirement does not give any explanations directed to any of items (i)-(iii) listed above. For these reasons, the Applicant submits that the restriction requirement in its present form does not conform to the form mandated by the MPEP.

Not a Serious Burden on the Examiner

According to MPEP § 803, for a restriction requirement to be proper, there must be a serious burden on the Examiner to consider all claims together. The Applicants submit that the restriction requirement is improper because all of the claims and, in particular, claims 17-18 and 23 have already been examined on the merits multiple times and, therefore, there would be no serious burden on the Examiner to finish examining the application if the withdrawn claims remained under consideration. Thus, it is submitted that the restriction requirement should be withdrawn.

Additional Considerations

In reliance on the withdrawals of all previous restriction requirements and indications of claim allowability, the Applicants had paid an extra-claim fee of \$1,000.00. This detrimental reliance provides an additional reason against additional claim restrictions.

The Applicants also note that this application has been pending at the USPTO for almost seven years, and multiple Examiner's attempts to improperly (as evidenced by the previous restriction withdrawals and the granted petition) use the restriction practice had unnecessarily stretched out the prosecution process. These Examiner's actions are inconsistent with the general MPEP command to "bring the prosecution to a speedy conclusion and at the same time deal justly with the patent owner and the public." If the restriction is maintained, then the Applicants request a refund of the extra-claim fee.

Conclusion

In view of the above remarks, the Applicants believe that the entire application is in proper condition for being examined on the merits and that the restriction requirement should be withdrawn.

Fees

During the pendency of this application, the Commissioner for Patents is hereby authorized to credit any overpayment to Mendelsohn, Drucker, & Associates, P.C. **Deposit Account No. 50-0782.**

The Commissioner for Patents is hereby authorized to treat any concurrent or future reply, requiring a petition for extension of time under 37 CFR § 1.136 for its timely submission, as incorporating a petition for extension of time for the appropriate length of time if not submitted with the reply.

Respectfully submitted,

Date: 05/05/2010
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